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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,426	02/25/2002	David J. Barton	L-13173	6740
7590	12/16/2003			EXAMINER
Fay, Sharpe, Fagan, Minnich & McKee, LLP 1100 Superior Avenue Seventh floor Cleveland, OH 44114			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	1
DATE MAILED: 12/16/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

Office Action Summary	Application No.	Applicant(s)	
	10/083,426	BARTON, DAVID J.	
	Examiner	Art Unit	
	Gregory Pickett	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-39, 41 and 43-47 is/are pending in the application.
 - 4a) Of the above claim(s) 33-38, 46 and 47 is/are withdrawn from consideration.
- 5) Claim(s) 3-29, 39 and 43-45 is/are allowed.
- 6) Claim(s) 2, 30-32 and 41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 33-38, 46 and 47 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 February 2002 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This Office Action acknowledges the applicant's Amendment A, presented as Paper No. 6. Claims 2-39, 41, and 43-47 are pending in the application. Claims 33-38, 46 and 47 are withdrawn from further consideration as directed to a non-elected species.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Applicant's election without traverse of Species 1 in Paper No. 6 is acknowledged.

Specification

4. In light of the applicant's amendment, the objection to the specification is hereby withdrawn.

Claim Objections

5. In light of the applicant's amendment, the objection to claim 39 is hereby withdrawn.

Claim Rejections - 35 USC § 112

6. Applicant has cancelled claim 40, rendering the rejection of claim 40, moot.

Claim Rejections - 35 USC § 103

7. Claims 2, 30-32, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata in view of Smith et al (GB 2 332 451).

Regarding claim 2, Nagata discloses a payout (Figure 6) for controlling the payout of a wire (3) from a coil of wire in a drum (1) having a drum axis, a drum body (1), and a core (2), wherein the payout comprises a first ring (41B), a second ring (41A), and a circular gap (51). The payout of Nagata is arranged and functions as claimed by the applicant. Nagata does not disclose a third ring overlaying the first and second rings.

Smith et al discloses a payout with a ring (2) disposed on the wire coil (6) for ensuring a smooth delivery of the wire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the payout of Nagata with a third ring as taught by Smith et al in order to provide for a smooth delivery of the wire.

As to claim 30, payout of Nagata-Smith discloses a first and second ring along with a gap that is coaxial with the drum axis (Nagata, Figure 6).

As to claims 31 and 32, the payout of Nagata-Smith discloses the claimed invention except for expressly disclosing the first, second, and third rings made of cardboard. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the payout of Nagata-Smith with first, second, and third

rings made of cardboard, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 41, the examiner interprets the claim as requiring three rings for operation. Nagata discloses a payout (Figure 6) for controlling the payout of wire (3) from a coil of wire in a drum (1) having a drum axis, a drum body (1), and a core (2), wherein the payout comprises a first ring (41A) laterally stationary with the drum axis, and another ring (41B). The payout of Nagata is arranged and functions as claimed by the applicant. Nagata meets all limitations claimed by the applicant except for the second ring.

Smith et al discloses a payout with a ring (2) disposed on the wire coil (6) for ensuring a smooth delivery of the wire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the payout of Nagata with a third ring as taught by Smith et al in order to provide for a smooth delivery of the wire. As such, the rings of Nagata-Smith cooperate to payout the wire. The payout of Nagata-Smith discloses a second ring (Smith, 2), which overlies the first ring (Nagata 41A) and functions as claimed by the applicant.

Allowable Subject Matter

8. Claims 3-29, 39, and 43-45 are allowed.

Response to Arguments

9. Applicant's arguments filed September 26, 2003 have been fully considered but they are not persuasive.

10. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine can be found in Smith which teaches the third ring to guide the payout wire (see for example, the abstract).

11. In response to applicant's argument that the combination of Smith and Nagata would produce a device that failed to work as intended, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, only the cone shaped ring of Smith is added to the device of Nagata and in no way would inhibit

the intended function of Nagata. As the third ring would have been conical in shape, it would have at least partly covered the gap.

12. In response to the applicant's arguments with respect to claim 41, while the payout of Nagata-Smith may have an additional ring structure, the combination still "reads on" the claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

Art Unit: 3728

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

gpr

Gregory Pickett
Examiner
December 14, 2003

mickeyyu

Mickey Yu
Supervisory Patent Examiner
Group 3700